

REMARKS

Initially, Applicants acknowledge with appreciation that the Examiner has allowed claims 1, 10-12, and 32.

In view of the allowance of claim 1, Applicants request rejoining withdrawn claim 37 in this application. Both claims 1 and 37 were presented in the originally filed application. Original claim 37 recites a formula have the same scope as that of original claim 1. According to MPEP 821.04:

“Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. ... However, if applicant elect claims directed to the product, and a product claim is subsequently found allowable, **withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined**” (emphasis added).

Note that claim 37 was amended in the same manner as claim 1 in Applicants' last response filed on August 23, 2005. See page 9, lines 4-6. In other words, claim 37, as amended, includes all of the limitations recited in allowed claim 1. As such, Applicants submit that claim 37 is now in condition to be rejoined in this application and is in condition for allowance.¹

The Examiner rejects claims 2-9 under 35 U.S.C. § 112, 2nd paragraph as being indefinite. Specifically, the Examiner points out that “[i]n claim 2, the R₂ ring being optionally substituted with a cyano lacks antecedent basis from claim 1 because of Applicants' current amendment to the definition of the R₂ variable in claim 1.” See the Office Action, page 3, line 15 to page 4, line 6.

Applicants have removed the group “cyano” recited in claim 2. No new matter has been introduced by this amendment. It is submitted that claim 2, thus amended, as well as claims 3-9 dependent therefrom, is no longer indefinite and request that this rejection be withdrawn.

Applicant submits that the grounds for rejection asserted by the Examiner have been overcome, and that claims 1-12, 32, and 37, as pending, define subject matter that is definite,

¹ The Examiner does not indicate in the final office action that she entered the amendments to claim 37 proposed in Applicants' last response. Thus, Applicants have kept in claim 37 the markings showing the proposed amendments.

Applicant : Chiung-Tong Chen et al.
Serial No. : 10/649,233
Filed : August 26, 2003
Page : 10 of 10

Attorney's Docket No.: 12563-019001

novel, and nonobvious. On this basis, it is respectfully submitted that all of the pending claims are now in condition for allowance, an action of which is requested.

Please apply any other charges to deposit account 06-1050, referencing Attorney's Docket No.: 12563-019001.

Respectfully submitted,

Date: _____

12-30-05



Y. Rocky Tsao, Ph.D., J.D.
Attorney for Applicants
Reg. No. 34,053

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906